

### **REMARKS**

Claims 1-14 stand rejected under 35 U.S.C. § 103(a) for obviousness over U.S. Patent No. 5,963,373 to Kayanoki. Applicants respectfully traverse this rejection in view of the amendments to claims 1 and 2 for the following reasons.

The present invention is directed to a coating liquid forming a hard coat film that includes a matrix and particles of a composite metal oxide. The composite metal oxide includes particles of  $\text{Fe}_2\text{O}_3$  and  $\text{TiO}_2$ . The resulting film exhibits no perceived photochromism or coloration upon weathering when the weight ratio of  $\text{Fe}_2\text{O}_3$  to  $\text{TiO}_2$  is 0.0005 to less than 0.005. Independent claims 1 and 2 have been amended to specify that there is no perceived photochromism for the claimed coating liquid that forms a hard coat film. Claims 1 and 2 have also been amended to specify that the claimed coating liquid does not exhibit coloration due to weathering. Data on perceived photochromism for the claimed weight ratio is graphically shown on page 3 of the Response filed December 29, 2003. Contrary to the assertions in the Advisory Action of February 5, 2004, the data points beyond 0.005 only show evidence of photochromism. The confusion about where the data points of the graph on page 3 fall may be due to the logarithmic scale for the x-axis of that graph. The shaded area of the graph represents data points between  $5 \times 10^{-4}$  to  $5 \times 10^{-3}$  for the metal oxide weight ratio.

None of these properties are described in relation to the compositions of the cited reference. In particular, the Kayanoki patent actually indicates that weather resistance is only imparted by adding an additional "weatherability-imparting agent" at col. 6, lines 10-13 or by including an additional anti-reflective film as described in col. 11, lines 39-42. A hard coating of Kayanoki having higher  $\text{Fe}_2\text{O}_3/\text{TiO}_2$  ratios apparently cannot achieve the properties of the present invention, wherein the weight ratio is less than 0.005.

This is consistent with the Comparative Example of the present invention having a weight ratio that falls within the range of Kayanoki and exhibit coloration from weathering. In order to prevent weathering of that Comparative Example, it also would have required an additional component such as the weatherability-imparting agent or the anti-reflective film described in the Kayanoki patent for enhancing weatherability.

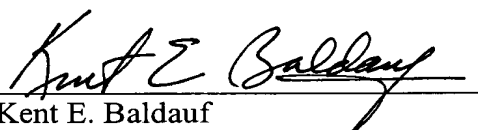
Application No. 09/581,604  
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Kayanoki is silent on photochromism. However, the data submitted in the Response of December 29, 2003 demonstrates that the compositions of Kayanoki (weight ratio at or above 0.005) would exhibit photochromism.

While Applicants acknowledge that the discovery of a new property of an old composition of matter does not necessarily lend patentability under the rule of *Titanium Metals v. Banner*, 778 F.2d. 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985), it is not always true that property limitations cannot have a meaning in the claim. *DuPont v. Phillips Petroleum*, 849 F.2d 1430, 7 U.S.P.Q.2D 1129 (Fed. Cir. 1988). Claims 1 and 2 which require that the coating liquid, when forming a hard coat film, exhibits no perceived photochromism or coloration from weathering are distinguishable from the compositions of Kayanoki which actually teach against such properties. The  $\text{Fe}_2\text{O}_3/\text{TiO}_2$  weight ratio ranges of the present invention and of Kayanoki are close, but Applicants have demonstrated that the two ranges (the claimed range and that of the prior art) have significantly different properties. As such, the claimed range and its properties provide a patentable feature over the prior art. In consideration of these rejections, allowance of claims 1-14 are respectfully requested.

Respectfully submitted,

WEBB ZIESENHEIM LOGSDON  
ORKIN & HANSON, P.C.

By   
Kent E. Baldauf  
Registration No. 25,826  
Attorney for Applicants  
436 Seventh Avenue  
700 Koppers Building  
Pittsburgh, PA 15219-1818  
Telephone: (412) 471-8815  
Facsimile: (412) 471-4094  
E-mail: webblaw@webblaw.com